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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/274,781 03/24/99 PEIFFER

H 07456.0009

EXAMINER

IM52/0809

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ART UNIT

PAPER NUMBER

1773

DATE MAILED:

08/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/274,781

Applicant(s)
PEIFFER et al

Examiner
Vivian Chen

Art Unit
1773



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 5/29/2001 and 6/26/2001.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-23 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-23 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

1. The indicated allowability of claims 1-14, 16-23 is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,054,212 (PEIFFER ET AL) in view of KIMURA ET AL (US 5,747,174).

U.S. Patent No. 6,054,212 (PEIFFER ET AL) claims multilayer polyester films as recited in Application 09/274781 claims 1-13, 15-17. However, the patent does not explicitly claim films with the recited functional coatings or surface tension.

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KIMURA ET AL discloses that it is well known in the art to surface treat multilayer polyester film such that the film has a surface tension of not less than 40 dynes/cm (lines 54-68, col. 8) prior to application of a functional coating such as an metal oxide or polymeric barrier layer and adhesion promoting layers (lines 31-53, col. 6) in order to obtain films with strongly adhered coatings, wherein the film is suitable for packaging, printing and other conventional applications using polyester film as recited in Application 09/274781 claims 1, 14-15, 18, 21-23.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a functional coating to the film claimed in U.S. Patent No. 6,054,212 (PEIFFER ET AL) and to adjust the thickness of said functional coating as indicated in claims 1, 15 depending on the type of coating material and the desired physical property. It is well known in the art to use polyester films as substrates in printing, packaging, and photographic applications as indicated in claims 18-23.

Claim Rejections - 35 USC § 103

4. Claims 1-3, 10, 12-15, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over IKUHARA ET AL (US 5,631,124) in view of KIMURA ET AL (US 5,747,174).

IKUHARA ET AL discloses a multilayer polyester film comprising of a polyester first layer and a second layer composed of a polyester mainly comprising ethylene naphthalate units and having a Tg greater than the first layer (Sample 102, 106 in Table 1), wherein the film is coextruded, biaxially oriented, and heat treated, followed by surface treatment by conventional

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means prior to application of a functional coating and a photosensitive coating (column 3; line 58, col. 11 to line 6, col. 13) as recited in claims 1-3, 10, 12, 15, 17, 19. However, the reference does not disclose the surface tension or functional coating thickness.

KIMURA ET AL discloses that it is well known in the art to surface treat multilayer polyester film such that the film has a surface tension of not less than 40 dynes/cm (lines 54-68, col. 8) prior to application of a functional coating such as an metal oxide or polymeric barrier layer and adhesion promoting layers (lines 31-53, col. 6) as recited in claims 1, 14-15, 19 in order to obtain films with strongly adhered coatings.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the thickness of an applied functional coating depending on the specific coating material and the desired physical property. It also would have been obvious to use conventional polymeric binders such as acrylics or polyesters as indicated in claim 14 in the functional coatings depending on the surface, adhesion, or other physical properties required for a given application. The Examiner has reason to believe that a blend of similar materials like two polyesters having different Tg values would typically have a Tg value which is between the Tg values of the individual components as recited in claims 1, 15, therefore the Examiner has basis for shifting the burden of proof to applicant as in In re Fitzgerald et al., 205 USPQ 594.

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Response to Arguments

5. Applicant's arguments filed 5/29/2001 with respect to claim 15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:00 PM and on alternate Fridays from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul Thibodeau, can be reached on (703) 308-2367.

For Art Unit 1773, the fax phone numbers are as follows:

official faxes:

(703) 305-3601

(703) 305-7718

unofficial faxes:

(703) 305-5436

(703) 305-3602

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (703) 308-0661.

VC
August 7, 2001


Vivian Chen
Primary Examiner
Group 1700